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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,420	01/18/2002	Peter Brune	0745/65813/NHZ	3904

7590

05/20/2004

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1185 Avenue of the Americas  
New York, NY 10036

EXAMINER
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PEREZ, JULIO R

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 05/20/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/936,420

**Applicant(s)**

BRUNE ET AL.

**Examiner**

Julio R Perez

**Art Unit**

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Ketcham (6075860).

Regarding claim 1, Ketcham discloses a method for distributing keys to subscribers in digital mobile radio networks, with the keys being generated, and possibly being stored if required, in a security device provided at the mobile radio network end and, on request by a subscriber, at least one key being requested from the security device and being transmitted via the mobile radio network to a mobile station or a terminal of the subscriber, characterized in that the transmitted key is allocated to that subscriber, and is stored in the terminal and/or in a subscriber identity module SIM in the mobile station (col. 7, lines 24-32 and 47-58; col. 8, lines 20-24, a random number is provided for authentication purposes to the subscriber, which is further stored in subscriber identity card or ISM).

Regarding claim 2, Ketcham discloses the method, characterized in that an SAT application is set up in the subscriber identity module SIM, in the mobile station, and carries out additional end-to-end encryption of the key transmitted between the mobile

station and the security device (col. 8, lines 1-4 and 24-30, an encryption process is executed between the remote terminal and the server).

Regarding claim 3, Ketcham discloses the method, characterized in that, in order to use the SAT application, the subscriber must identify himself to the subscriber identity module SIM by entering a PIN (col. 6, lines 34-41, the subscriber may easily interact with the mobile terminal in order to access it securely).

Regarding claim 4, Ketcham discloses the method, characterized in that the transmitted key is stored in a protected memory area in the subscriber identity module SIM (col. 8, lines 23-45, GSM SIM cards provide capabilities to store key words or numbers).

Regarding claim 5, Ketcham discloses the method, characterized in that the key is transmitted via a traffic channel in the mobile radio network (col. 7, lines 38-40, a channel is dedicated to transfer authentication random key numbers).

Regarding claim 6, Ketcham discloses the method, characterized in that the key is transmitted in the form of a short message SM via a signaling channel in the mobile radio network (col. 8, lines 30-37, short messages are used in GSM systems to provide signaling).

Regarding claim 7, Ketcham discloses the method, characterized in that, when the key is requested, the subscriber's authorization is checked by evaluating a mobile subscriber telephone number MSISDN for the subscriber (col. 7, lines 1-16; col. 8, lines 51-62, authentication to the network is provided through the verification of the subscriber's own telephone number or MSID).

Regarding claim 8, Ketcham discloses the method as claimed in claim 1, characterized in that, the security device sends the key, which is transmitted to the subscriber to one or more added value service nodes (col. 7, lines 28-32; col. 8, lines 46-62, the authentication number may be provider to service providers for accessing purposes to their services).

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the art with respect to systems for authorizing and verifying subscriber identities.

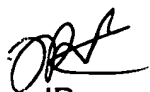
US Pat. NO. 6338140 to Owens et al.	Method and system for subscriber validation
US Pat. NO. 6078908 to Schmitz et al.	Authorization in data transmission systems


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julio R Perez whose telephone number is (703) 305-8637. The examiner can normally be reached on Monday - Friday, 7:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika Gary can be reached on (703) 308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2681

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JP  
5/14/04

  
ERIKA GABY  
PATENT EXAMINER